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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,997	04/15/2004	Jerry Joseph	RESEM.P-003	7274
28752 7590 03/20/2007 LACKENBACH SIEGEL, LLP LACKENBACH SIEGEL BUILDING 1 CHASE ROAD SCARSDALE, NY 10583			EXAMINER RODRIGUEZ, PAMELA	
			ART UNIT	PAPER NUMBER
			3683	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/824,997

Applicant(s)

JOSEPH, JERRY

Examiner

Pam Rodriguez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5,7-10 and 12-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,7-10,12-14 and 17-20 is/are rejected.
- 7) ☒ Claim(s) 15 and 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 30, 2006 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, 4, 5, 7-10, 12-14, and 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,169,244 to Siebert et al.

Regarding Claim 1, Siebert et al disclose a bushing member 19 (see Figure 2), having all the features of the instant invention including: an elastomeric member 3/4 defining a central opening 10 between a front face and a rear face (the front and rear faces being the thicknesses of portions 3 and 4, the front face of which is visible in Figure 2, the rear face being located on the back side width of elements 3 and 4); a slot

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7 in said bushing along a first side of said elastomeric member providing a lateral access from an exterior of said elastomer member to said central opening (see Figure 2); hinge means 5 for reducing an opening force of said elastomeric member and for easing said lateral access to said central opening; and at least a part of said hinge means 5 for reducing positioned proximate a second side of said elastomeric member distal said slot 7 (see Figure 2), whereby during an opening of said bushing member said hinge means reduces an opening force required for separating said slot and inserting an external member into said central opening and improves a smooth transfer of said external member into said slot (see column 3 lines 5-20), and a first and a second flange member 3/8 and 4/8 extending outwardly from an outer edge portion of said elastomeric member $\frac{3}{4}$ proximate respective said front face and said rear face (see Figure 2), thereby providing a saddle portion of the elastomeric member therebetween (see Figure 5, where the saddle portion is the portion of elastomeric member $\frac{3}{4}$ on which bracket 14 is located thereon, in particular the portion of elastomeric member $\frac{3}{4}$ underneath portion 15 of the bracket).

Regarding Claim 2, Siebert et al disclose an outer seal member 9 on each respective said front and rear face; and each said outer seal members 9 bounding said central opening 10 and joining respective sides of said slot 7 to provide a seal with said external member (see Figure 4), whereby when said external member is assembled with said bushing member each said outer seal member 9 provides a sealing contact with said external member and minimizes a debris entry to said central opening (see Figure 4).

Regarding Claim 4, Siebert et al disclose that the first and said second flange members 3/8 and 4/8 define respective hinge portions 5 proximate said second side wherein a thickness of respective said flange members is reduced (see Figure 2), said hinge means 5 for reducing includes said respective hinge portions; and said hinge portions minimizing said opening force of said elastomeric member 3/4 and easing said lateral access to said central opening 10 during an insertion of said external member, whereby an opening stress on said bushing member is minimized and a risk of damaging said bushing member is reduced.

Regarding Claim 5, see Claims 1 and 2 above.

Regarding Claim 7, see Claim 4.

Regarding Claim 8, see Claims 1-2.

Regarding Claim 9, see Claim 4.

Regarding Claim 10, see Claim 1 above and further note bracket member 14 (see Figure 5) bounding a portion of the elastomeric member 3/4, whereby when assembled the bracket member is shaped to slide over a saddle portion of the elastomeric member (see Figure 5 and the portion of the elastomeric member 3/4 which bracket member 14 is located thereon), whereby the saddle portion is between respective spaced apart first and second flange members 8 (see Figure 5 and elements 12, which cover flanges 8).

Regarding Claim 12, see Claim 4.

Regarding Claim 13, see Claim 2.

Regarding Claim 14, Siebert et al further disclose means 17 for positioning and stiffening the bracket member 14, a first and a second edge member in the means for positioning (see Figure 7 and the edges of elements 17), and wherein the first and second edge members extend away from an outer portion of the bracket member (see Figure 5), whereby the edge members provide at least a guiding alignment to the elastomeric member during an assembly (see column 4 lines 1-9).

Regarding Claim 17, see Claims 1-2 and 10.

Regarding Claim 18, see Claim 14.

Regarding Claim 19, see Claims 1-2 and 10.

Regarding Claim 20, Siebert et al disclose the step of compressing the elastomeric member $\frac{3}{4}$ sufficiently to press closed the slot 7 and provide a leak resistant seal along at least the slot thereby minimizing moisture access to the external member (note that bracket 14 would compress member $\frac{3}{4}$ to lock slot 7 closed, thus providing some sort of sealing function at the slot itself).

Allowable Subject Matter

4. Claims 15 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

5. Applicant's arguments filed November 30, 2006 have been fully considered but they are not persuasive.

At the onset of applicant's remarks, he expresses confusion over the examiner's position in view of alleged clear differences between his invention and that of the applied Siebert reference. He explicitly requests specific citings of the structural requirements in the independent claims and a corresponding teaching within the Siebert reference to enable the examiner's position to be better understood.

In response to this, the examiner has made every attempt both in the previous office actions and in the instant office action to denote, as specifically as possible, how the elements of Siebert correspond to applicant's recited claim features. The examiner had/has made every attempt to provide applicant with a clear concise explanation of how the Siebert reference reads on the instant claims, as well as indicate the status of all remaining claims.

Applicant then goes on to argue that the claim language requires the central opening to define front and rear faces to be spaced apart/separate from each other and perpendicular to the axis of the opening and that the Siebert reference does not teach this.

In response to this, the examiner contends that applicant's remarks are more specific than the claim language. Applicant merely recites that the elastomeric member have a central opening, which, in Siebert, is opening 10, and that a front face and a rear face also be present. Thus, as outlined above, if the front face and rear face are

defined to be the thicknesses of elastomeric member elements 3 and 4, these faces would be spaced apart from one another, i.e., by the width of elements 3 and 4. Note that applicant makes no claim as to how these faces must be spaced or located perpendicular to the axis of the opening.

Applicant then argues that Siebert does not teach a single elastomeric member having a continuous hinge that surrounds and defines the central opening. Applicant contends that Siebert discloses two separable parts joined by a narrow hinge tab such that each face of the elastomeric member of Siebert is split in half.

In response to this, here applicant's remarks are again more specific than the claims. Applicant merely requires that a hinge reduce an opening force of the elastomeric member and ease lateral access to the opening. Hinge 5 of Siebert performs these very functions. Nowhere does applicant claim any specifics of the hinge structure that would preclude the use of a hinge tab such as Siebert's.

Next, applicant argues that the claims require two separate flange members and that each of the members is spaced separate from each other and close to the front and rear faces, meaning extending generally perpendicularly to the central axis and not in the middle of the elastomeric member distal from the faces as in the Siebert reference.

In response to this, here elements 8 perform the claimed function. Each of elements 8 are two separate flange members and each is spaced apart from each other and close to the previously defined front and rear faces at least when viewed from the plane of Figure 2 of Siebert. Again, applicant has not claimed that the flanges are perpendicular to the central axis and not in the middle of the elastomeric member.

And lastly, applicant argues that the claims require that the two flange members extend from outer edge portions of the faces. Applicant contends that Siebert's element 8 is in the middle of the field distant from the so-defined front and rear faces which prevents the generation of a saddle region.

Here, applicant claims that the outer edge portions extend from the elastomeric member proximate the front and rear faces, not that the flange members extend from the outer edge portions of the faces as stated in his remarks. Thus, when elements 8 are read in light of the claims, they do extend from at least a portion of the outer edges of elements 3 and 4 and are certainly near the front and rear faces of the member.

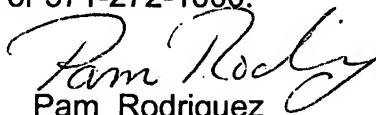
In conclusion, it appears that the main difference between applicant's invention and that of Siebert, is the overall positioning and location of the saddle region with respect to the flange members. The examiner recognizes that applicant's saddle region extends the entire length of the elastomeric member and is encompassed/formed by two continuous flange members, the flanges extending across the entire width of the outer edge portions of the elastomeric member. This marked difference, however, is not presented in the claims and thus, the examiner contends that the Siebert reference does still teach the claim limitations as drafted.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pam Rodriguez whose telephone number is 571-272-7122. The examiner can normally be reached on Mondays 5:30 AM -4 PM and Tuesdays 5 AM -11 AM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim McClellan can be reached on 571-272-6786. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Pam Rodriguez
Primary Examiner
Art Unit 3683

2/12/07

PR
02/12/07